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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,904	12/28/1999	MARK S. CHEE	A-67493-2RFT	1618

7590 05/15/2002

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EXAMINER

FRIEND, TOMAS H F

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 05/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/473,904

Applicant(s)

CHEE ET AL.

Examiner

Tomas Friend

Art Unit

1627

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 April 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 April 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, first paragraph, of claims 20, 33, and 34.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

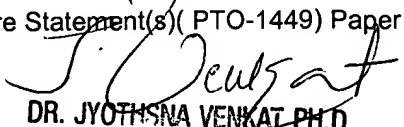
Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 18-34.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


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Tomas Friend, Ph.D. (formerly
Thomas Prasthofer) 5/14/02


Continuation of 2. NOTE: The limitations "each assay location comprising an array location" and "each array location comprising an array location" in proposed amended claims 18 and 19 are not supported on page 2, lines 34-36 of the specification.

The proposed amendments raise issues of new matter and do not overcome the prior art rejections of record. Applicant argues that Walt et al. do not disclose every element of the claimed invention. The Walt et al. reference, however, discloses "groups of fibers" that anticipate a plurality of array locations; individual fibers, each carrying a single bead, anticipating a plurality of discrete sites; and an optical fiber bundle, which anticipates a plurality of assay locations. Applicant argues that the Walt et al. reference is silent with respect to scaling up the number of analytes to be screened. One of ordinary skill in the art would have been motivated to scale up the number of analytes to be screened for because doing so would save both time and money.

Consequently, the rejections under 35 U.S.C. 102(e) and 103 (a) are maintained.

Applicant's proposed amendment to claim 18 would require additional search because the limitation "each assay location comprising an array location" has not been searched.

Applicant's proposed amendment to claim 19 would raise issues under 35 U.S.C. 112, second paragraph, because the phrase "each array location comprising an array location" appears to be redundant.


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